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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/684,012

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Babak Rezvani

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EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,012

Applicant(s)

REZVANI ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19, 20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19, 20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-17, 19, 20, 22 and 23 have been examined.

Responses to Amendments/Arguments

2. In response to the new amendments the Examiner has rejected claims 1, 14, and 23 under 112 Second Paragraph. Specifically, the new rejections are directed to lack of antecedent basis (i.e. "the number of tokens") and the case where N, the number of additional transmissions, is equal to zero. In the amended claims 1, 14 and 23, the Applicant recites "at least one token", a better recitation is, perhaps, transmitting "N unique tokens and a checksum.... where N is a positive number and defines the number of additional transmissions until another set of tokens is required." Further, if N=0, then there are no additional transmissions and the other limitations that depend on an at least second transmission do not occur.

The following assertion of facts has gone unchallenged by the Applicant and are not considered prior art:

- Checksums

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 14 and 23 recite the transmission of a "selected value of N". However, the claim also recites the limitation of setting "the number of tokens being set to a variable N". Therefore, to one of ordinary skill the term "selected value of N" means a client transmitting to a server a "subset" of the N number of tokens. The Specification, on the other hand, recites a client informing a server the value of N and transmitting N tokens for future authentication (Specification, amended page 28).

Claims 2-13 and 15-19, 20 and 22, are also rejected as they depend from claims 1 and 14 respectively.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 14 and 23 recite a variable N that defines the additional number of transmissions used to authenticate a user. However, if $N=0$, then there are no additional transactions and the Applicant's system does not perform as claimed.

Claims 2-13, 15-19, 20, and 22 are also rejected as they depend from claims 1, 14 or 23.

b. Claims 1 and 23 recite the limitation "the number of tokens" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-13 are also rejected as they depend from claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-17, 19, 20 and 22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, U.S. Patent No. 6,012,144.

As per claims 1-3 and 6-17, Pickett teaches a transaction security method and apparatus comprising:

- transmitting a token to a receiver during first secure transmission between a sender and receiver (abstract; figure 4; column 3, lines 50-52)
- establishing at least one additional transmission between the sender and receiver for transmitting the token, wherein the additional transmission is variable and adaptively selected (figures 4 and 5; column 3, lines 50-54; column 6, lines 22-35)
- comparing the tokens received during the transmissions to establish authenticity (figures 4 and 5; column 6, lines 23-35 and 64-67)
- wherein the at least one token comprises and corresponds to a preselected number of tokens sent during a first secure transmission (figures 4 and 5)
- conducting transmissions over unsecure or open connections (figure 1)

- conducting an encrypted first secure transmission (figures 3A-4; column/lines 5/1-6/23)
- additional transmissions that are sent in plaintext (figures 1 and 5; column 6, lines 22-35)
- transmitting an acknowledgement from the server to the client upon successful receipt and processing of the first transmission by the client (column 4, lines 4-14)

Pickett also teaches a sender computer transmitting to a receiver computer a selected value of N and N number of tokens to be used to authenticate the sender computer (figures 4 and 5) as, for the case of N=1, the user "informs" the server of the value of N by registering at least one token to be used for future purchases. As per claims 12, 13, 16 and 17, Pickett teaches transmitting data electronically (figures 1-5). The Examiner takes Official Notice that checksums are well known computational tools for detecting the presence of errors when data is transmitted over a network. Therefore, it would have been obvious to one of ordinary skill to use "checksums" to detect errors during the transmission of sensitive data such as credit card numbers.

As per claims 4, 5, and 22, Pickett teaches a secure transaction method that comprises multiple transmissions and the exchange of token data (figures 4 and 5). Pickett does not specify a particular number of additional transmissions. However, it would have been obvious for a user to register multiple cards but

only make one purchase using the service of Pickett, or register one card and make multiple purchases using the one card. Similarly, as the number of additional transactions of the Pickett system is variable, the number can be ascertained mathematically (i.e. deterministically), or at least statistically, or probabilistically. And the choice independent variables used to model the behavior of said variable as at the discretion of the practitioner.

As per claims 19 and 20, Pickett teaches a secure transaction method that comprises additional transmissions to a client (figure 5). Regarding the number of additional transmissions, it would have been obvious for a user to decline using the system of Pickett, or at least a particular website (i.e. ABC Toy Company), (figure 5) in the future if the user was dissatisfied with the service.

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, U.S. Patent No. 6,012,144 in view of Maher, U.S. Patent No. 6,125,349.

As per claim 23, Pickett teaches a method and system for authenticating transferred data between a sender computer and receiver computer comprising:

- transmitting a token to a receiver during first secure transmission between a sender and receiver (abstract; figure 4; column 3, lines 50-52)
- establishing at least one additional transmission between the sender and receiver for transmitting the token, wherein the

additional transmission is variable and adaptively selected (figures 4 and 5; column 3, lines 50-54; column 6, lines 22-35)

- comparing the tokens received during the transmissions to establish authenticity (figures 4 and 5; column 6, lines 23-35 and 64-67)
- wherein the at least one token comprises and corresponds to a preselected number of tokens sent during a first secure transmission (figures 4 and 5)

Pickett also teaches a sender computer transmitting to a receiver computer a selected value of N and N number of tokens to be used to authenticate the sender computer (figures 4 and 5). However, Pickett does not explicitly recite specific criteria as input in an algorithm to determine the number of additional transmissions. Maher teaches a system for authenticating transferred data between a sender computer and receiver computer that uses an algorithm to determine additional transmissions based on frequency of transmissions between sender and receiver, proximity of the sender computer to the receiver computer or usage pattern of the sender (column 6, lines 25-48; column 7, lines 5-25). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Pickett and Maher in order to increase usage of the system through a rewards program (column 7, lines 5-25).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

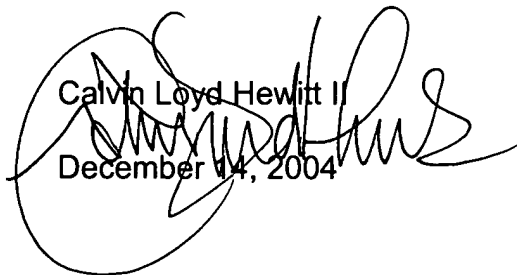
or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.


Calvin Lloyd Hewitt II
December 14, 2004